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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/743,523

Applicant(s)

LEE ET AL.

Examiner

TANIA ASHBY

Art Unit

1611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22, 24-59, 61-80 and 84-92 is/are pending in the application.
- 4a) Of the above claim(s) 1-22, 24-59, 61-73, 76-78, 84 and 87-88 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 74, 75, 79, 80, 85, 86 and 89-92 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Prioritization's Patent Drawing Review (PTO-544)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgement is made to Applicant's response filed April 28, 2009.

Status of the Claims

Instant claims 74, 75, 79-80, 85-86 and 89-92 are the subject of this office action.

Rejections Withdrawn

In light of Applicant's amendments filed April 28, 2009, the 103(a) rejection in regards to claims 74-75, 79-80 and 85-86 over Okada et al. and Suzuki et al. in view of Yau et al. and in further view of Giron et al. and Chapman et al. has been withdrawn.

In light of the cancellation of claims 32-34 in reference application 11/172,977, the provisional obviousness-type double patenting rejection over claims 74-75, 79-80, 85 and 86 has been withdrawn.

Claim Objections

Claims 74-75, 79-80 and 89-92 are objected to as depending from a withdrawn base claim.

Appropriate correction is required.

For purposes of examination, claims 74-75, 79-80 and 89-92 have been interpreted to encompass the properties of the base claims.

New Grounds of Rejection Necessitated by the Amendments

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 74-75, 79-80, 85-86 and 89-92 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The newly amended claims recite the limitation of an organic coloring agent to be incorporated into the instant composition. However, Applicant's elected species for the coloring agent (please see the election response dated April 30, 2007) encompasses brown, yellow or black iron oxides coated with perfluoroalkyl phosphate. It is unclear what limitation Applicant intends to invoke because the general knowledge of the art is such that if a pigment or coloring agent contains a metal such as iron, the pigment or coloring agent is inorganic. This newly added limitation of an *organic* coloring agent appears to directly conflict with Applicant's elected species and thus the metes and bounds of the claim cannot be determined and the claim is rendered indefinite. Claims 89-92 are further rendered indefinite by the phrase "free of free titanium dioxide." It is unclear what "free titanium dioxide" is in regards to the instant claims. It is thought that Applicant meant to state "free of titanium dioxide" and for purposes of examination, the examiner has interpreted the claim as such.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 74-75, 79-80 and 85-86 are rejected under 103(a) as being unpatentable over Okada et al. (U.S. Patent 5,463,009) and Suzuki et al. (U.S. Patent 6,759,052), in view of Yau (U.S. Patent 6,109,921), in further view of Giron et al. (U.S. 2003/0067545 A1),

Chapman et al. (US Patent 6,121,192), and Herbst et al. (Industrial Organic Pigments, published 1993).

Okada et al. (US Patent 5,463,009) teach fluorine-modified silicone derived perfluoroalkyl water-repellant cosmetics for use in protecting the skin from water or for preventing makeup up from getting disordered by water or sweat in the form, for example, cosmetics for foundation (col. 1, line 17 col. 2, line 19; see cols. 11-13, Examples 4-8). Okada et al. disclose an evaluation method for applying the foundation for wearability, retention, and feel on the skin (col. 11, line 52 to col. 12, line 18). Okada et al. exemplify compositions comprising iron oxide red, yellow, and black (= applicant's elected coloring agent), fluorine compounded-treated pigments, glycerin and water (cols. 11-12, Table 2). Okada et al. teach that the retention of the foundation was evaluated in terms of the degree of removal of the foundation from the skin 8 hours after application. Okada et al. teach that other cosmetic ingredients may be included in the composition, including colorants, such as organic and inorganic pigments, organic dyes, as well as fluorine compound- treated pigment to prevent makeup from getting disordered due to sebum (col. 5, lines 25-49). Okada et al. exemplify compositions comprising iron oxide red, yellow, and black (= applicant's elected coloring agent), fluorine compounded-treated pigments, and water (cols. 11-12, Table 2).

Okada et al. do not teach compositions comprising mica brown iron oxide (i.e. applicant's elected reflective particle species), wherein said composition have and is silent regarding methods for making up dark skin or lightening dark skin comprising a composition having hue angle h ranging from 40 degrees to 70 degrees, an a saturation C* ranging from 20 to 50.

Suzuki et al. (US Patent 6,759,052) teach a liquid eye shadow cosmetic composition comprising iron oxide coated titanated mica, perfluoropolyether, purified water (col. 22, Example 32).

Yau (US Patent 6,109,921) teaches methods for making up dark skin using a mannequin model, including the application of foundations (col. 6, lines 14-47). Yau suggest that differences due to ethnic and/or racial origin need to be considered when applying makeup (col. 6, lines 14-47).

Giron et al. (US Patent Application Pub. No. 2003/0067545 A1) is added to show the general state of knowledge regarding use of CIE 1976 color scheme. Giron et al. teach a calibration device that allows the acquisition of colorimetric coordinates at a point of the image, which can be part of a reference colorimetric space, such as, for example the space according to the CIE 1976 CIELAB system; the calibration device permits the measurement of differences in color, shade and clarity, and is advantageous when a person's appearance is compared before and after a treatment with a care product or an application of a makeup.

Chapman et al. (US Patent 6,121,192) is added to show the general state of knowledge regarding compositions comprising colorants and use of CIE and hue angles as parameters for expressing colors (col. 1, line 52 to col. 2, line 51). Chapman et al. teach orange ink manufactured as a reference material and its CIELAB color coordinates measured at a status T density of 1.49, wherein CIELAB was used to express colors in terms of three parameters. L^* , a^* , and b^* (cols. 9-10). A plot of a^* versus b^* values for a color sample can be used to accurately show where that sample lies in color space i.e. hue (col. 10, lines 19-37). Chapman et al. teach that color differences can also be expressed in terms of a hue angle and saturation C^* (col. 10, lines 39-56). Chapman et al. teach that an orange dye-donor element provides a close match to

an orange printing ink control (col. 10, lines 57-60). It is noted that Chapman is being relied upon to only show that methods for determining CIELAB color coordinates with respect hue angles, and saturation C* are known.

Herbst et al. is added to show the advantages of using organic pigments.

It is noted that active method steps of applying a composition comprising both coloring agents and reflective particles in the same composition are considered to be the functional equivalent of applying a composition/coat comprising the coloring agent as a separate composition (= a first composition or first coat) and applying a second composition (or second coat) comprising the reflective particles because the end treatment effect would be the same in the absence of unexpected results. Further, it is the examiner's position that it would have been routine in the cosmetic art at the time the invention was made to modify the reflectance of the composition without undue experimentation.

It would have obvious to a person of skill in the art at the time the invention was made to add the iron oxide coated titanated mica (= reflective material) composition as taught by Suzuki et al. to the composition comprising iron oxide (= coloring agent), and water (= physiologically acceptable medium) taught by Okada et al. for additive coloring effects. One would have been motivated to add the iron oxide coated titanated mica composition to the composition comprising iron oxide (= coloring agent), and water (= physiologically acceptable medium because Okada et al. suggest that colorants may be added to the composition.

Also, it would have been obvious to a person of skill in the art at the time the invention was made to treat dark skin as taught by Yau by applying the composition comprising iron oxide and iron oxide coated titanated mica to said skin for makeup effects. One would have been

motivated to treat dark skin via by applying the composition via the mannequin model because Yau suggest that ethnic/racial differences need to be considered when applying makeup and both Okada et al. and Suzuki et al. teach makeup compositions.

Further, it would have been obvious to a person of skill in the art at the time the invention was made to use the CIE 1976 scheme taught by Giron et al. to determine the color coordinates of the coloring agents of the composition. One would have been motivated to use the CIE 1976 scheme to determine the color coordinates of the coloring agent of the composition because Giron et al. teach a calibration device that allows the acquisition of colorimetric coordinates at a point of the image, which can be part of a reference colorimetric space, such as, for example the space according to the CIE 1976 CIELAB system calibration device permits the measurement of differences in color, shade and clarity, and which is advantageous when a person's appearance is compared before and after a treatment with a care product or an application of a makeup and Okada et al., Suzuki et al., and Yau all directed to methods of applying makeup.

In addition, it would have been obvious to a person of skill in the art at the time the invention was made to modify the hue angle and saturation C^* of the composition as taught by Chapman et al., including the instant claimed hue angle and saturation C^* , for cosmetic effects. Although Chapman is directed to ink composition, its teaching of methods for determining CIELAB color coordinates with respect hue angles, and saturation C^* is considered to be relevant regarding the determination of CIELAB coordinates. One would have been motivated to modify the hue angle and saturation C^* of the composition for cosmetic effects because both Chapman et al. and Giron et al. teach CIE 1976 color scheme, while both Okada et al., Suzuki et

al. and Yau are directed to methods of applying makeup compositions comprising coloring agents. Hence, the cited art is found to be capable of performing the desired function.

It would have been prima facie obvious to one having ordinary skill in the art at the time of the invention to use an organic pigment in the preparation. One would have been motivated to do so looking towards the teaching of Okada et al. that organic pigments are acceptable (column 5, lines 25-49) and further motivated by the advantages described throughout Herbst. More specifically, Herbst teaches that organic pigments are advantageous because they are lower in toxicity, both acute and after repeated application (page 595). Further, they show very low irritation effects (Table 37). Such effects are especially advantageous in a topical composition and to the instant method.

Regarding the limitation of "having reflectance with a dominant wavelength of a yellow or orange coloration in a range from 550 to 675 nm," Okada et al. teaches the instantly elected coloring agent (i.e. yellow, red and black iron oxides) and such pigments, more specifically yellow and red iron oxides and their mixtures, would inherently possess the instantly claimed wavelength range (the fact that these pigments have wavelengths within this nanometer region is what makes them yellow, orange or red).

Thus, a person of skill in the art at the time the invention was made would have found it obvious to create the instant claimed invention with reasonable predictability.

Claims 89-92 are rejected under 103(a) as being unpatentable over Okada et al. (U.S. Patent 5,463,009) and Suzuki et al. (U.S. Patent 6,759,052), in view of Yau (U.S. Patent 6,109,921), in further view of Giron et al. (U.S. 2003/0067545 A1), Chapman et al. (US Patent 6,121,192), and Herbst et al. (Industrial Organic Pigments, published 1993), as

applied to claims 74-75, 79-80 and 85-86 above, and further in view of Fornay (African-American woman's guide, published 2002).

Okada et al., Suzuki et al., Yau, Giron et al., Chapman et al. and Herbst et al. are incorporated herein as applied above.

None of the above references teach a composition or method of applying a composition that is free of titanium dioxide.

Fornay is drawn to a make-up and skin care guide specifically for women with darker skin. On page 80, Fornay teaches that titanium dioxide gives an ashy or gray look to black (i.e. African-American or dark) skin.

It would have been prima facie obvious to one having ordinary skill in the art at the time of the invention to combine Okada et al., Suzuki et al., Yau, Giron et al., Chapman et al. and Herbst et al. with the teachings of Fornay and make the composition instantly claimed in the method titanium dioxide free. One would have been motivated to do so because Fornay teaches that titanium dioxide gives an undesirable ashy or gray appearance to dark skin.

Claims 74-75, 79-80, 85-86 and 89-92 are rejected under 103(a) as being unpatentable over Simon (U.S. 6,451,294, issued September 17,2002) in view of Okada et al. (US Patent 5,463,009), and Yau (US Patent 6,109,921), and in further view of Giron et al. (US Patent Application Pub. No. 2003/0067545 A1), Chapman et al. (US Patent 6,121,192), Herbst et al. (Industrial Organic Pigments, published 1993) and Fornay (African-American woman's guide, published 2002).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

The above discussions of Okada et al. (US Patent 5,463,009 and Yau (US Patent 6,109,921), and in further view of Giron et al. (US Patent Application Pub. No. 2003/0067545 A1), Chapman et al. (US Patent 6,121,192), Herbst et al. and Fornay are incorporated here as stated above.

The art rejection is not limited to the '294 claims so you could use rely on any relevant disclosure in the '294 patent as prior art in this rejection. So there may be additional disclosure in the '294 patent, such that you don't need to rely on all of the above references. Done see additions.

US Patent 6,451,294 ('294) discloses a method for making up human skin, lips, and/or exoskeletal appendages (e.g., see claims 7 and 39-41) comprising applying a composition process for making up skin comprising a composition comprising a dye. '294 further discusses the invention as a kit comprising two makeup compositions, each having at least one pigment (column 1, lines 13-21) and teaches that the light incidence and viewing angle should be considered in the use of the compositions (column 2, lines 22-31). '294 further teaches the use of nacreous pigments such as mica coated with titanium dioxide or iron dioxide (column 5, lines 58-65, also applicant's elected reflective particle species).

It would have been prima facie obvious to a person of skill in the art at the time the invention was made to add reflective particles as taught by the prior cited art for application to dark skin for additive cosmetic effect. One would have been motivated to add reflective particles to the composition for its additive cosmetic effect because the '294 reference and the cited art are concerned with making up of the skin and further concerned with the effect that light incidence and viewing angle have on the results of the application of the makeup (and coloring agents/reflective particles) to the face (abstract).

"It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980)."

Thus, in view of the cited prior art, it would have been prima facie obvious to the skilled artisan to arrive at the instantly claimed invention.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 74-75, 79-80, 85-86 and 89-92 are also rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 7, and 39-41 of US Patent 6,451,294, in view of Okada et al. (US Patent 5,463,009), Suzuki et al. (US Patent 6,759,052), and Yau (US Patent 6,109,921), and in further view of Giron et al. (US Patent Application Pub. No. 2003/0067545 A1), Chapman et al. (US Patent 6,121,192), Herbst et al. (Industrial Organic Pigments, published 1993) and Fornay (African-American woman’s guide, published 2002).

The above discussions of Okada et al. (US Patent 5,463,009), Suzuki et al. (US Patent 6,759,052), and Yau (US Patent 6,109,921), and in further view of Giron et al. (US Patent

Application Pub. No. 2003/0067545 A1), Chapman et al. (US Patent 6,121,192), Herbst et al. and Fornay are incorporated here as stated above.

Claim 7 of US Patent 6,451,294 is directed towards a method for making up human skin, lips, and/or exoskeletal appendages (also recited by claims 39-41) comprising applying a composition process for making up skin comprising a composition comprising a dye. Unlike the instant claims, the reference claims are not directed to a method of making up dark skin comprising applying a composition comprising reflective particles. However, it would have been obvious to a person of skill in the art at the time the invention was made to add reflective particles as taught by the prior cited art for application to dark skin for additive cosmetic effect. One would have been motivated to add reflective particles to the composition for its additive cosmetic effect because the reference claims and the cited art are concerned with making up of the skin.

Further, it would have been prima facie obvious to one having ordinary skill in the art at the time of the invention to use an organic pigment in the preparation. One would have been motivated to do so looking towards the teaching of Okada et al. that organic pigments are acceptable (column 5, lines 25-49) and further motivated by the advantages described throughout Herbst. More specifically, Herbst teaches that organic pigments are advantageous because they are lower in toxicity, both acute and after repeated application (page 595). Further, they show very low irritation effects (Table 37). Such effects are especially advantageous in a topical composition and to the instant method.

It also would have been prima facie obvious to one having ordinary skill in the art at the time of the invention to make the composition instantly claimed in the method titanium dioxide

free. One would have been motivated to do so because Fornay teaches that titanium dioxide gives an undesirable ashy or gray appearance to dark skin.

Thus, a person of skill in the art at the time the invention was made would have deemed the instant claims to be an obvious variant of the reference claims in view of the cited prior art.

Claims 74-75, 79-80, 85-86 and 89-92 are directed to an invention not patentably distinct from claims 7 and 39-41 of commonly assigned US Patent 6,451,294. Specifically, see above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned US Patent 6,451,294, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

It is noted that Applicant has provided a declaration under 37 CFR 1.132 and that this declaration is rendered moot in light of the amendments made by Applicant in the response filed April 28, 2009. However, information contained in the declaration may still be relevant to the amended claims and thus is addressed below.

Response to Arguments

The declaration under 37 CFR 1.132 filed April 28, 2009 is insufficient to overcome the rejection of claims 74-75, 79-80 and 85-86 based upon the 103(a) rejection over Okada et al. and Suzuki et al. in view of Yau et al. and in further view of Giron et al. and Chapman et al. as set forth in the last Office action because: The declaration fails to set forth facts of unexpected results. It is noted that the declaration sets forth a comparison between composition A and composition B, where composition A includes an organic pigment, namely Yellow 6 Lake. Composition B does not include this pigment and is therefore concluded as being inferior in terms of providing a less grey or ashen appearance. This is not found persuasive for the following reasons:

- Composition B includes a significantly larger amount of black iron oxide than composition A, which would be expected to attribute a more grey or ashen appearance to composition B.
- Using similar reasoning as above, Composition B comprises dramatically different amounts of other pigments in the composition as opposed to Composition A, including yellow, brown and black iron oxides, along with titanium dioxide and mica titanium dioxides. Thus, the difference in amounts and inclusion of such pigments may result in Composition B attributing a more grey or ashen appearance than Composition A. In such a case, the addition of Yellow 6

Lake is not the cause behind a less ashen and grey appearance, rather, it is the difference in ratios of other pigments included in the composition.

· Further, even a comparison of two compositions identical to one another with the exception of the addition of Yellow 6 Lake to one and not the other, the reported results would not be unexpected. It is well known in the art that the addition of "warmer" colors such as yellows or browns would result in a composition, and thus the appearance of a surface when the composition is applied, that attributes a less grey or less ashen tone.

· Even further, the declaration has not shown that the achieved appearance difference is a result of the claimed color agent being *organic* as opposed to *inorganic*. To elaborate, the declaration has, at best, only made an attempt at showing that the addition of a *yellow* pigment (not any other organic color agents, such as black or white organic color agents, etc.) to a composition achieves a less grey appearance when applied to a surface. This appears that the result achieved is merely a function of the *color* of the agent and not the fact that it is organic versus inorganic.

· It is also noted that the current claims reflect an organic coloring agent nonspecific to Yellow 6 Lake. Thus, the showing is not commensurate in scope with the claims.

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TANIA ASHBY whose telephone number is (571)270-1348. The examiner can normally be reached on Monday through Friday, 7:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on (571) 272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/TA/

/David J Blanchard/
Primary Examiner, Art Unit 1643